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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/158,728	09/22/1998	STEVEN CRAIG WEIRATHER	310048-355	4296

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EXAMINER

CHEVALIER, ALICIA ANN

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 04/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/158,728	<b>Applicant(s)</b> WEIRATHER ET AL.	
	<b>Examiner</b> Alicia Chevalier	<b>Art Unit</b> 1772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 January 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 479-531 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 479-531 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>8-10-04, 1-24-05, 9-21-04</u> | 6) <input type="checkbox"/> Other: _____  |

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## **RESPONSE TO AMENDMENT**

### ***Request for Continued Examination***

1. The Request for Continued Examination (RCE) under 37 CFR 1.53 (d) filed on January 24, 2005 is acceptable and a RCE has been established. An action on the RCE follows.
2. Claims 479-531 are pending in the application, claims 1-478 have been cancelled.

### ***REJECTIONS***

3. **The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.**

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 479-531 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In the instant case amended claim 479 and other, contain the limitation "carrier sheet," which does not appear in the specification. The specification only has support for liner sheet (*page 8, lines 20-21*).

The new matter should be deleted.

***Claim Rejections - 35 USC § 102***

6. Claims 479, 481, 482, 495, 498, 499, 504, 524, 528, 529 are rejected under 35 U.S.C. 102(b) as being anticipated by Kennedy, Jr. (U.S. Patent No. 3,420,364).

Regarding Applicant's claim 479, Kennedy discloses a printable business card sheet (*strip of tags, title*) comprising a dry laminate sheet construction including a facestock sheet construction (*tag material, col. 1, line 65*) and a continuous carrier sheet (*backing, col. 1, line 63*) attached to a back side of the facestock sheet construction (*figures 2 and 3*).

Facestock continuous through-cut lines (*die cuts, col. 2, line 34*) pass through the facestock sheet construction to the back side but not through-cut through the carrier sheet (*figure 2*). The through-cut lines are deemed to define at least in part perimeter edges of printable business cards and a matrix waste portion (*skeleton, col. 2, line 35*) around the printable business cards (*figures 1-3*).

The dry laminate sheet construction is deemed to be sized, constructed and adapted to be sheet-fed through a printer or copier for a printing operation on the printable business cards, since the reference discloses that the strip of tags may be of any desired shape which permits the tags to be printed in a computer or other printing apparatus (*col. 1, lines 23-29*), i.e. the tag sheet can be feed into a computer printer.

Areas of the carrier sheet are positioned over the back sides of all the through-cut lines and thereby the carrier sheet is constructed and adapted to hold the printable business cards and the matrix waste portion together during the printing operation (*figure 2 and col. 2, lines 40-41*).

The top surface of the facestock sheet construction is deemed to be constructed and adapted to receive indicia printed on the top surface during the printing operation (*figure 2*), i.e. the top surface of the tag is considered to be the side that receives the ink from the printing operation (*col. 1, lines 25-26*).

The carrier sheet and the through-cut lines being constructed and adapted to allow the business cards to be removed and separated from the carrier sheet and from the matrix waste portion after the printing operation into individual printed business cards whose back side surfaces are non-tacky (*col. 2, lines 51-56*).

The preamble/limitation “business card” is deemed to be a statement with regard to the intended use and is not further limiting in so far as the structure of the product is concerned. In article claims, a claimed intended use must result in a ***structural difference*** between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. MPEP § 2111.02. Applicant has defined that “business card” as the cut out portion or separable portion of the sheet construction (*specification page 1, lines 3-7 and page 3, line 25 through page 4, line 9*). Kennedy’s tag is deemed to meet this limitation because Kennedy’s tag is also the cut out portion of the printable material, i.e. sheet construction (*figures 1-3*).

Regarding Applicant’s claims 481 and 529, Kennedy discloses that the carrier sheet is a solid continuous carrier sheet and covers all of the back sides of all of the through-cut lines (*figure 2*), since the backing is not die cut (*col. 2, lines 36-40*). In other words the areas of the carrier sheet cover the back sides of all the through cut-lines.

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Regarding Applicant's claim 482, Kennedy discloses that the carrier sheet is a solid continuous carrier sheet which extends the entire width of the facestock sheet construction (*figure 2*).

Regarding Applicant's claims 495 and 504, Kennedy discloses the carrier sheet includes a base paper sheet (*tag stock, col. 1, line 63*).

Regarding Applicant's claim 498, Kennedy discloses that the carrier sheet covers the entire back side of the facestock sheet construction (*figure 2*).

Regarding Applicant's claim 499, Kennedy discloses that the through-cut lines define all of the perimeter edges of all of the printable business cards (*figure 1*).

Regarding Applicant's claim 524, Kennedy disclose that the carrier sheet is secured directly to the back side of the facestock sheet construction and a back side of the carrier sheet is deemed to define a back surface of the printable business card sheet (*figures 1-3*).

Regarding Applicant's claim 528, Kennedy discloses that portions of the facestock sheet construction form back side surfaces of the printable business card (*figures 1-3*).

7. Claims 479, 481, 484, 485, 491, 499, 505, 507, 524, 528 and 529 are rejected under 35 U.S.C. 102(b) as being anticipated by Garrison (U.S. Patent No. 5,466,013).

Regarding Applicant's claim 479, Garrison discloses a printable business card sheet (*card intermediate, title*) comprising a dry laminate sheet construction including a facestock sheet construction (*form, col. 2, line 65*) and a continuous carrier sheet (*second transparent film, col. 2, line 33*) attached to a back side of the facestock sheet construction (*figure 2*).

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Facestock continuous through-cut lines (*diecuts, col. 2, line 40*) pass through the facestock sheet construction to the back side but not through-cut through the carrier sheet (*figure 2*). The through-cut lines are deemed to define at least in part perimeter edges of printable business cards and a matrix waste portion around the printable business cards (*figures 1 and 2*).

The dry laminate sheet construction is deemed to be sized, constructed and adapted to be sheet-fed through a printer or copier for a printing operation on the printable business cards (*col. 2, lines 20-26 and lines 58-61 and col. 3, lines 4-5*).

Areas of the carrier sheet are positioned over the back sides of all the through-cut lines and thereby the carrier sheet is constructed and adapted to hold the printable business cards and the matrix waste portion together during the printing operation (*figure 2*).

The top surface of the facestock sheet construction is deemed to be constructed and adapted to receive indicia printed on the top surface during the printing operation (*figures 1 and 2*), i.e. the top surface of the from layer, i.e. the card, is considered to be the side that receives the ink from the printing operation (*col. 2, lines 20-26*).

The carrier sheet and the through-cut lines are deemed to be constructed and adapted to allow the business cards to be removed and separated from the carrier sheet and from the matrix waste portion after the printing operation into individual printed business cards whose back side surfaces are non-tacky, since the second transparent film, i.e. the carrier sheet, is attached to the facestock sheet construction with a dry adhesive, i.e. non-tacky, that readily rupturable (*col. 2, lines 32-36*).

The preamble/limitation "business card" is deemed to be a statement with regard to the intended use and is not further limiting in so far as the structure of the product is concerned. In

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article claims, a claimed intended use must result in a **structural difference** between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. MPEP § 2111.02. Applicant has defined that “business card” as the cut out portion or separable portion of the sheet construction (*specification page 1, lines 3-7 and page 3, line 25 through page 4, line 9*). Garrison’s ID card (*col. 2, line 17*) is deemed to meet this limitation because Garrison’s tag is also the cut out portion of the printable material (*col. 2, lines 40-46*).

Regarding Applicant’s claims 481 and 529, Garrison discloses that the carrier sheet is a solid continuous carrier sheet and covers all of the back sides of all of the through-cut lines (*figure 2*), since the backing is not die cut (*col. 2, lines 40-42*). In other words the areas of the carrier sheet cover the back sides of all the through cut-lines.

Regarding Applicant’s claim 484, Garrison discloses that the printable business cards are arranged in a grid on the facestock sheet construction (*figure 1*).

Regarding Applicant’s claims 485 and 505, Garrison discloses that the face stock sheet construction includes a facestock sheet (*form, col. 2, line 28*), an adhesive layer (*pressure sensitive adhesive, col. 2, line 30*) and a film layer (*first transparent film, col. 2, line 34*).

Regarding Applicant’s claim 491, Garrison discloses that the through-cut lines include vertical and horizontal cut lines (*figure 1*).

Regarding Applicant’s claim 499, Garrison discloses that the through-cut lines define all of the perimeter edges of all of the printable business cards (*figure 1*).

Regarding Applicant’s claim 502, Garrison discloses that the printable business cards are arranged in a two column matrix on the facestock sheet construction (*figure 1*).



Regarding Applicant's claim 507, Garrison discloses that the facestock sheet construction includes a cardstock sheet (*col. 2, lines 52-53*).

Regarding Applicant's claim 524, Garrison disclose that the carrier sheet is secured directly to the back side of the facestock sheet construction and a back side of the carrier sheet is deemed to define a back surface of the printable business card sheet (*figures 2*).

Regarding Applicant's claim 528, Garrison discloses that portions of the facestock sheet construction form back side surfaces of the printable business card (*figures 1 and 2*).

#### ***Claim Rejections - 35 USC § 103***

8. Claims 479-514 and 524-529 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cross (U.S. Patent No. 4,863,772) in view of Popat et al. (U.S. Patent No. 5,407,718).

Cross discloses a label stock with a dry separation interface, used as tags, coupons identification cards and the like (*col. 1, lines 7-9*) that may then be used in a computerized printing of names and addresses on dry labels or cards by the printer of a PC computer (*col. 4, lines 51-53*).

Regarding Applicant's claim 479, Cross discloses a printable business card sheet (*label stock, title*) comprising a dry laminate sheet construction including a facestock sheet construction (*label construction, col. 5, line 23*) and a continuous carrier sheet (*liner proper, col. 5, line 14*) attached to a back side of the facestock sheet construction (*figure 5*). The facestock sheet construction may also includes through-cut lines (*die-cutting, col. 4, lines 45-46*).

The dry laminate sheet construction is deemed to be sized, constructed and adapted to be sheet-fed through a printer or copier for a printing operation on the printable business cards,

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since the reference discloses that the label stock may then be used for computerized printing on dry label or cards by the printer of a PC computer (*col. 4, lines 51-53*).

The top surface of the facestock sheet construction is deemed to be constructed and adapted to receive indicia printed on the top surface during the printing operation (*col. 4, lines 51-53*).

The carrier sheet and the through-cut lines are deemed to be constructed and adapted to allow the business cards to be removed and separated from the carrier sheet after the printing operation into individual printed business cards whose back side surfaces are non-tacky, since the reference discloses that the labels will be picked-off individually by the user (*col. 4, lines 47-48*) and that the dry labels of the invention have no tack when individually handled (*col. 1, lines 9-10*).

The preamble/limitation "business card" is deemed to be a statement with regard to the intended use and is not further limiting in so far as the structure of the product is concerned. In article claims, a claimed intended use must result in a ***structural difference*** between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. MPEP § 2111.02. Applicant has defined that "business card" as the cut out portion or separable portion of the sheet construction (*specification page 1, lines 3-7 and page 3, line 25 through page 4, line 9*). Cross' labels are deemed to meet this limitation because Cross' labels are also the cut out portion of the printable material.

Cross fails to disclose that the facestock continuous through-cut lines pass through the facestock sheet construction to the back side but not through-cut through the carrier sheet and that the through-cut lines are deemed to define at least in part perimeter edges of printable

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business cards and a matrix waste portion around the printable business cards or areas of the carrier sheet are positioned over the back sides of all the through-cut lines and thereby the carrier sheet is constructed and adapted to hold the printable business cards and the matrix waste portion together during the printing operation.

Popat teaches label sheets used for printing with personal computers (*col. 1, lines 12-19*). The label sheets comprise a sheet construction that comprises a label layer, i.e. facestock sheet construction, and an adhesive layer, and backing layer (*col. 2, lines 64-68*), which acts as a release liner (*col. 3, lines 18-19*), i.e. carrier sheet.

Popat's label comprises facestock continuous through-cut lines (*die cut lines, col. 3, line 15*) that pass through the facestock sheet construction to the back side but not through-cut through the carrier sheet (*col. 3, lines 15-21*) and that the through-cut lines are deemed to define at least in part perimeter edges of printable business cards and a matrix waste portion around the printable business cards (*figure 1*).

Areas of the carrier sheet are positioned over the back sides of all the through-cut lines and thereby the carrier sheet is constructed and adapted to hold the printable business cards and the matrix waste portion together during the printing operation (*figure 2 and col. 3, lines 15-21*).

The carrier sheet and the through-cut lines are deemed to be constructed and adapted to allow the business cards to be removed and separated from the carrier sheet and from the matrix waste portion after the printing operation into individual printed business cards (*figure 1 and col. 3, lines 15-21*).

The die cuts also help facilitate ease of feeding into complex printer paths, such as those found on laser printers (*col. 3, lines 1-4*).

Cross and Popat are analogous because they are both discuss label sheets used for printing with personal computers.

It would have been obvious to one of ordinary skill in the art at the time of the invention to use the die cut arrangement of the through-cut lines with the cuts only going through the facestock construction and not the carrier sheet of Popat as the die cuttings of Cross in order to help facilitate ease of feeding into complex printer paths, such as those found on laser printers (*Popat col. 3, lines 1-4*). Furthermore, it would have been an obvious matter of design choice to change the configuration of the through-cut lines, since a modification would have involved a mere change in size of the label. A change in size or shape is generally recognized as being within the level of ordinary skill in the art, absent unexpected results. MPEP 2144.04 (I) and (IV).

It is desirable to use Popat's through-cut lines configuration in order to maximize the number of labels per sheet.

Regarding Applicant's claims 480-484, 486, 487, 491-494, 498, 499, 502, 503, 514, and 529, figures 1 and 2 in Popat shows:

That the printable business cards form a block of printable business cards and the matrix waste portion forms a frame around the block.

That the carrier sheet is a solid continuous carrier sheet and covers all of the back sides of all the through-cut lines.

The carrier sheet is a solid continuous carrier sheet which extends the entire width of the facestock sheet construction

Adjacent ones of the printable business cards directly abut one another.

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The printable business cards are arranged in a grid on the facestock sheet construction.

The facestock sheet construction includes left and right side edges and first and second end edges, the through-cut lines include frame cut lines and grid cut lines, the frame cut lines include first and second side cut lines spaced in from the left and right side edges respectively, and disposed parallel thereto, and first and second end cut lines spaced in from and parallel to the first and second end edges, both of the end cut lines engaging both of the side cut lines, the frame cut lines defining a central area on the facestock sheet construction, the grid cut lines defining a central area, and the grid cut lines and the frame cut lines separating the central area into the printable business cards.

That some of the grid lines extend across and outwardly of the first and second side cut lines.

That the through-cut lines include vertical and horizontal cut lines.

That a top one of the horizontal cut lines extends a full width of the facestock sheet construction.

The ends of the rest of the horizontal cut lines are space inwardly from the left and right side edges of the facestock sheet construction.

The rest of the horizontal cut lines extend a distance out beyond the outermost of the vertical cut lines.

The carrier sheet covers the entire back side of the facestock sheet construction.

The through-cut lines define all of the perimeter edges of all the printable business cards.

The printable business cards are arranged in a two column matrix on the facestock sheet construction.

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The printable business cards in each column of the two column matrix abut adjacent printable business cards in the same column separated only by respective ones of the through-cut lines.

The facestock sheet construction and the carrier sheet are both rectangular and have the same width and length dimensions.

The areas of the carrier sheet cover the back sides of all the through-cut lines.

Regarding Applicant's claim 485, Cross discloses the facestock sheet construction includes a facestock sheet (*facestock proper*, *col. 4, lines 30-31*) and an adhesive layer (*adhesive*, *col. 4, line 32*).

Regarding Applicant's claims 488, 495-497 and 504, Cross discloses that the carrier sheet comprises includes a base paper sheet of densified bleached kraft sheet, since the reference discloses the liner proper is a base paper sheet such as densified bleached kraft sheet (*col. 5, lines 32-34*). The liner proper is 3.1 mil thick (*col. 5, line 32*), which is deemed to be *approximately* 3.0 mil and *approximately* 2.0 mil.

Regarding Applicant's claims 489 and 490, Cross discloses that the facestock sheet construction and dry laminate sheet construction includes a polyethylene layer (*col. 5, lines 13-16 and figure 5*).

Regarding Applicant's claims 500 and 501, Cross discloses that the facestock sheet construction includes a facestock sheet (*facestock proper*, *col. 4, line 44*) and dry laminate sheet construction includes a polyethylene layer (*col. 5, lines 13-16 and figure 5*) between the facestock sheet and the carrier sheet which includes a paper sheet (*liner proper of kraft paper*, *col. 5, line 14 and 32-34*).

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Regarding Applicant's claim 505-513, Cross discloses the facestock sheet construction includes a facestock/cardstock sheet (*facestock proper*, col. 4, lines 30-31) and an adhesive layer (*adhesive*, col. 4, line 32) and a film layer (*polyethylene layer*, col. 5, lines 13-16 and figure 5). The film layer is low-density polyethylene film (col. 5, line 6) and carrier sheet is a densified bleached kraft liner sheet (col. 5, line 14 and 32-34).

It is noted that Cross does not disclose the adhesive being a hot melt adhesive or claimed thickness of the layers.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use a hot melt adhesive for the adhesive for the dry release film layer, since it would have been within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use, unless hot melts adhesives give unexpected results. *In re Leshin*, 125 USPQ 416.

Furthermore, the exact thickness of the layers is deemed to be a result effective variable with regard to size of paper acceptable for sending through a printer. It would require routine experimentation to determine the optimum value of a result effective variable, such as combined thickness of layers, in the absence of a showing of criticality in the claimed combined thickness. *In re Boesch*, 205 USPQ 215 (CCPA 1980), *In re Woodruff*, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990). One of ordinary skill in the art would have been motivated to change the size of the layers in order to accommodate the machine in which the sheet was intended to be used with.

Regarding Applicant's claim 524, Cross discloses the carrier sheet is secured directly to the back side of the face stock sheet construction and a back side of the carrier sheet defines a back surface of the printable business card sheet (figure 5).

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Regarding Applicant's claims 525-527, Cross fails to disclose that the dry laminate sheet construction is 8.5 by 11 inches, 8.5 by 14 inches or has A4 width and length dimensions.

Popat discloses that the label sheet may be a standard 8.5 by 11 inch sheet or other dimensions such as sheets with smaller dimensions, legal size or various other sizes which allow for printing the labels in a variety of different printers, including laser, ink jet and xerographic printers (*col. 5, lines 1-11*).

Therefore, it would have been an obvious matter of design choice to change the size of sheet construction, since a modification would have involved a mere change in size. A change in size or shape is generally recognized as being within the level of ordinary skill in the art, absent unexpected results. MPEP 2144.04 (I) and (IV).

One of ordinary skill in the art would have been motivated to change the size of the sheet construction in order to allow for printing the labels in a variety of different printers, including laser, ink jet and xerographic printers (*Popat col. 5, lines 1-11*).

Regarding Applicant's claim 528, Cross discloses that portions of the facestock sheet construction form back side surfaces of the printable business cards (*figure 5*).

9. Claims 515 and 516 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cross in view of Popat as applied above, and further in view of Hickenbotham et al. (U.S. Patent No. 4,704,317).

Cross and Popat are relied upon as described above.



Cross and Popat fail to disclose an infeed edge of the printable business card sheet, along an entire width of the sheet is thinner than a body of the sheet or a lead-in edge of the printable business card sheet is calendared.

Examiner's comment: The limitation "the lead-in edge of the printable business card sheet is calendared" is a process limitation. However, this process limitation does add structure to the end product by crushing, compressing, making the calendared end thinner. So, for purposes of examination, any process that results in a crushed, compressed or thinner end is taken to anticipate the limitation "the lead-in edge of the printable business card sheet is calendared," since the method of forming the product is not germane to the issue of patentability of the product itself.

Hickenbotham discloses crushing the corner of lablestock for use in printers or copier to provide a diagonal path of relatively low stiffness (*col. 6, lines 9-16*). The low stiffness in the front edge of the sheet allows the sheet to be dispensed through the printer or copier with greater easier (*col. 1, lines 38-51*).

Cross, Popat and Hickenbotham are analogous because they all disclose label constructions.

It would have been obvious to one of ordinary skill in the art at the time of the invention to crush the edge of the sheet suggested by the combination of Cross and Popat above, as taught by Hickenbotham, in order to make the edge thinner than the rest of the sheet and to facilitate dispensing.

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One of ordinary skill in the art would have been motivated to crush the edge of the sheet because crushing the edge would provide a path of relatively low stiffness and would make the sheet easier to be dispensed through a printer as taught by Hickenbotham at col. 1, lines 38-51.

It is desirable to have the sheet be easily dispensed through a printer so that the sheet does not get jammed in the printer.

10. Claims 517-523 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cross in view of Popat as applied above, and further in view of Klein (U.S. Patent No. 5,198,275).

Cross and Popat are relied upon as described above.

Cross and Popat fail to disclose that the carrier sheet includes a flexibility line that is a cut line.

Klein discloses a card stock sheet for labels (*col. 3, line 13*) comprising a lift out panel with rectangular score cuts, an adhesive, and a backing sheet with perforations (*figure 6*). The backing sheet with perforations corresponds to Applicant's carrier sheet with flexibility/cut lines. The perforations ensure a smooth peripheral edge of each panel and smoothness of the edge at the panel face is enhanced without any roughness or frying or torn paper (*col. 3, lines 62-66*).

Cross, Popat and Klein are analogous because they all disclose label constructions.

It would have been obvious to one of ordinary skill in the art at the time of the invention to add Klein's perforations to the web suggested by the combination of Popat and Cross in order to facilitate easy removal of the web. One of ordinary skill in the art would have been motivated to use Klein's perforations as taught in col. 3, lines 62-66, where Klein teaches that the perforations ensure a smooth peripheral edge without any roughness of frying or torn paper.

The exact distance of the liner sheet cut lines to the end of the sheet is deemed to be a result effective variable. It would have been obvious to one having ordinary skill in the art to have determined the optimum value of a result effective variable, such as distance of liner sheet cut line to the end of the sheet through routine experimentation in the absence of a showing of criticality in the claimed combined thickness. *In re Boesch*, 205 USPQ 215 (CCPA 1980), *In re Woodruff*, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990).

11. Claims 530 and 531 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cross in view of Popat as applied above, and further in view of Carlson (U.S. Patent No. 5,842,722).

Cross and Popat are relied upon as described above.

Cross and Popat fail to disclose that the facestock sheet construction comprises a top coating that forms a top receptive surface of each of the printable business cards.

Carlson discloses a printable laminate useful in forming die-cut identification cards, labels, etc. (*col. 1, lines 16-18*). The printable laminate includes die cut cards, which are coated with an ink receptive coating (*col. 19, line 50 through col. 20, line 3*). The ink receptive coating provides good ink image retention and adhesive retention (*col. 20, lines 1-3*).

Cross, Popat and Carlson are analogous because they all disclose label constructions.

It would have been obvious to one of ordinary skill in the art at the time of the invention to add Carlson's ink receptive coating to the facestock sheet construction suggested by the combination of Cross and Popat in order to enhance the adhesion of the ink to the label. One of ordinary skill in the art would have been motivated to employ Carlson's ink receptive coating because of the improved image retention and adhesive retention of the ink (*col. 20, lines 1-3*). It

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is desirable to enhance the adhesion of the ink to the label so that the ink would not rub off after being applied to the label.

### ***ANSWERS TO APPLICANT'S ARGUMENTS***

12. Applicant's arguments in the response filed January 24, 2005 regarding the 35 USC 103 rejection over Cross in view of Popat of record have been carefully considered but are deemed unpersuasive.

Applicant argues that combination of Cross and Popat would render Cross unsatisfactory for its intended purpose. Specifically that Cross discloses a construction, which is printed by the manufacture and not by the end user.

The Examiner disagrees that Cross is solely directed to printing by a manufacture. Cross discloses that the end user may then use the stock for computerized printing of names and addresses on the dry labels or cards by the printer of a PC computer (*col. 4, lines 50-53*).

Applicant argues that lay-flat is not a concern for the web of Cross, because Cross does not disclose a sheet that is printable by a user, only one that is printed during the manufacturing process.

As discussed above Cross discloses that the sheet is printable by a user. Furthermore, Attorney argument is not evidence unless it is an admission, in which case, an examiner may use the admission in making a rejection. See MPEP § 2129 and § 2144.03 for a discussion of admissions as prior art. The arguments of counsel cannot take the place of evidence in the record. See MPEP § 716.01(c) for examples of attorney statements which are not evidence and

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which must be supported by an appropriate affidavit or declaration. Therefore, Applicant must submit evidence that Cross' sheet does not lay-flat from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art.

In response to applicant's arguments against that Cross does not disclose a matrix waste portion as claimed in claim 479, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicant argues that since Popat is concerned with adhesive labels and not with business cards having backs sides that are non-tacky that one would not modify the teachings of Cross with Popat.

First, as discussed in the rejections above, the preamble/limitation "business card" is deemed to be a statement with regard to the intended use and is not further limiting in so far as the structure of the product is concerned. In article claims, a claimed intended use must result in a **structural difference** between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. MPEP § 2111.02. Applicant has defined that "business card" as the cut out portion or separable portion of the sheet construction (*specification page 1, lines 3-7 and page 3, line 25 through page 4, line 9*). Therefore, the labels of Cross and Popat are deemed to meet this limitation because the labels are also the cut out portions of the printable sheets.

Second, both Cross and Popat are directed to labels for computerized printing on a personal home computer.

Third, the arrangement of the labels on the sheet is not dependent on whether the labels are adhesive or dry release.

Furthermore, as stated above it would have been obvious to one of ordinary skill in the art at the time of the invention to use the die cut arrangement of the through-cut lines with the cuts only going through the facestock construction and not the carrier sheet of Popat as the die cuttings of Cross in order to help facilitate ease of feeding into complex printer paths, such as those found on laser printers (*Popat col. 3, lines 1-4*). Furthermore, it would have been an obvious matter of design choice to change the configuration of the through-cut lines, since a modification would have involved a mere change in size of the label. A change in size or shape is generally recognized as being within the level of ordinary skill in the art, absent unexpected results. MPEP 2144.04 (I) and (IV). It is desirable to use Popat's through-cut lines configuration in order to maximize the number of labels per sheet.

### ***Conclusion***

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Capozzola (U.S. Patent No. 4,858,957), Buchholz (U.S. Patent No. 4,890,862), McKillip (U.S. Patent No. 5,219,183), McKillip (U.S. Patent No. 5,462,488), Longtin et al. (U.S. Patent No. 5,632,511), Butterworth (U.S. Patent No. 2,321,184) and Viby (WO 95/34879) all disclose similar sheets.

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14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia Chevalier whose telephone number is (571) 272-1490.

The examiner can normally be reached on Monday through Friday from 8:00 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon, can be reached on (571) 272-1498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in cursive script that reads "Alicia Chevalier".

Alicia Chevalier

4/13/05